No. 94-1437

(6)

MOTION FILED

MAR 29 1995

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

CONOPCO, INC., D/B/A CHESEBROUGH-POND'S USA CO.,

Petitioner,

—v.—

MAY DEPARTMENT STORES COMPANY, VENTURE STORES, INC., THE BENJAMIN ANSEHL COMPANY and KESSLER CONTAINERS, LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITION

ALBERT ROBIN*
MORTON DAVID GOLDBERG
BRUCE P. KELLER
Attorneys for International Trademark Association
1133 Avenue of the Americas
New York, New York 10036-6710
(212) 768-9887

**Counsel of Record*

18 pp

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

No. 94-1437

CONOPCO, INC., D/B/A CHESEBROUGH-POND'S USA CO.,

Petitioner,

—v.—

MAY DEPARTMENT STORES COMPANY, VENTURE STORES, INC., THE BENJAMIN ANSEHL COMPANY and KESSLER CONTAINERS, LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION AS AMICUS CURIAE

International Trademark Association (INTA), a not-for-profit corporation whose more than 2,800 members have an interest in trademarks and trade dress, respectfully moves for leave to file the attached brief *amicus curiae* in this trade dress infringement case. The consent of the attorney for petitioner has been obtained. The consent of the attorneys for each of the respondents was requested but refused.

In today's marketplace in which the purchasing decision for many products and services is based on visual communication, trade dress serves a selection function that is at least as significant as that served by trademarks, and needs no less protection. In *Two Pesos Inc.* v. *Taco Cabana Inc.*, 120 L.Ed.2d 615, 112 S.Ct. 2753 (1992), the Court recognized this need and applied to the trade dress case before it the same analytical approach as is applicable to cases of trademark infringement.

The decision of the Federal Circuit below, however, neither cited *Two Pesos* nor followed its approach, and accorded trade dress a different, and lesser, level of protection than trademarks. The public is affected by this decision since it needs protection from the deception which results from infringing trade dress. INTA and its members are affected by this decision since INTA members own trade dress under which their goods and services are marketed and need to protect this trade dress against infringement. If, as the Federal Circuit decided, infringement can be avoided solely by the display of the putative infringer's name or mark, the interests of both the public and trade dress owners will be adversely impacted.

The decision below applied the approach rejected in *Two Pesos*: a different analysis for trade dress protection than for trademark protection. INTA'S brief *amicus curiae* focuses on why the same analysis and level of protection should be applicable to both. INTA respectfully requests that its motion be granted and that its brief be considered by the Court in connection with the petitioner's request for the grant of a Writ of Certiorari.

Respectfully submitted,

/s/ ALBERT ROBIN

ALBERT ROBIN*
MORTON DAVID GOLDBERG
BRUCE P. KELLER
Attorneys for International Trademark Association
1133 Avenue of the Americas
New York, New York 10036-6710
(212) 768-9887

**Counsel of Record*

TABLE OF CONTENTS

	PAGE
Interest of Amicus Curiae	2
Summary of Argument	4
Argument	4
A. The Decision of the Federal Circuit Ignores The Decision in *Two Pesos Inc.* v. *Taco Cabana Inc.*	4
B. Since the Typical Imitator in a Trade Dress Case Also Displays Its Own Name or Logo, the Federal Circuit's Decision Makes Trade Dress Protection Meaningless and Conflicts with Those of Other Circuits	7
C. In Substituting Its Own Factfinding for the Trial Court's Finding of Likelihood of Confusion, the Federal Circuit Contravened the Stated Intent of the Lanham Act to Protect Consumers From Deception	8
Conclusion	11

TABLE OF AUTHORITIES

Cases	PAGE
Allied Materials and Equipment v. Pappa Gepetto's Toys, 28 USPQ2d 1862 (D.Kan. 1993)	5
Badger Meter Inc. v. Grinnel Corp., 13 F.3d 1145 (7th Cir. 1994)	7
Charles Jacquin Et Cie v. Destileria Serralles, 921 F.2d 467 (3d Cir. 1990)	7
Fremont Co. v. ITT Continental Baking Co., Inc., 199 USPQ 415 (S.D.N.Y. 1977)	10
L.A. Gear Inc. v. Thom McAn Shoe Co., 988 F.2d 1117 (Fed. Cir. 1993), *cert. denied*, 114 S.Ct. 291, 126 L.Ed.2d 240 (1993)	9
Menendez v. Holt, 128 U.S. 514 (1888)	6
Morton v. Rank America Inc., 812 F. Supp. 1062 (C.D. Cal. 1993)	5
Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (9th Cir. 1987), *cert. denied*, 488 U.S. 933 (1988)	11
Nabisco Brands Inc. v. Conusa Corp., 14 USPQ 2d 1324 (4th Cir. 1989)	7
Paddington Corp. v. Attiki Importers & Distrib., 996 F.2d 577 (2d Cir. 1993)	7
Rubbermaid v. Contico Intern., 836 F. Supp. 1247 (W.D. Va. 1993)	5
SquirtCo. v. Seven-Up Co., 207 USPQ 12, 22 (E.D.Mo. 1979) aff'd 628 F.2d 1086 (8th Cir. 1980)	6, 8

PAGE

Two Pesos Inc. v. Taco Cabana Inc., 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992) 2, 4

Statutes

15 U.S.C. § 1071(a) 8

15 U.S.C. § 1127 9

15 U.S.C. § 1125(a) 2, 4

28 U.S.C. § 1295 8

Miscellaneous

134 Congressional Record S 16974 (daily ed. October 20, 1988) 3

1 J. Gilson, *Trademark Protection and Practice* § 7.02[7](g), p. 7-86 5

1 J. McCarthy, *Trademarks and Unfair Competition* § 8.01[5], p. 8-11 (3d ed.) 5

Restatement (Third) of Unfair Competition § 16, pp. 156-57 5

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

No. 94-1437

CONOPCO, INC., D/B/A CHESEBROUGH-POND'S USA CO.,

Petitioner,

—v.—

MAY DEPARTMENT STORES COMPANY, VENTURE STORES, INC., THE BENJAMIN ANSEHL COMPANY and KESSLER CONTAINERS, LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF AMICUS CURIAE OF INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITION

Upon motion for leave submitted herewith pursuant to Rule 37.4 of the Rules of the Court, the International Trademark Association ("INTA") respectfully submits this Brief Amicus Curiae.

In today's marketplace, the purchasing decision for many products and services is based on visual communication. Trade dress serves a selection function at least as significant as that served by trademarks. Thus, trade dress needs no less protection than trademarks. In an effort to insure such pro-

tection, INTA filed a brief *amicus curiae* in *Two Pesos Inc.* v. *Taco Cabana Inc.*, 112 S.Ct. 2753, 120 L.Ed.2d 615 (1992).

The Court's decision in *Two Pesos* recognized the need. It stated that trade dress, which it described as "the features of a product design," is "capable of distinguishing" products in the modern marketplace if such trade dress either is inherently distinctive or has acquired secondary meaning. 112 S.Ct. at 2759, 120 L.Ed.2d at 626. Because Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), "provides no basis for distinguishing between trademarks and trade dress," and the copier of either "may be seen as falsely claiming that his products may for some reason be thought of as originating from the plaintiff," the Court recognized that the protection of both trademarks and trade dress under the Lanham Act served the same purpose of "preventing deception and unfair competition." *Id.* at 2759-2760. Accordingly, the Court acknowledged that the same analytical approach to determining infringement was to be applied in either case.

The Court's decision in *Two Pesos* brought needed certainty to the law of trade dress. That certainty, however, is undercut by the decision of the Federal Circuit in the instant case, a decision that cannot be reconciled with *Two Pesos*.

INTA urges the Court to grant certiorari because the decision of the Federal Circuit in the instant case directly contravenes the teaching of *Two Pesos* and will encourage widespread copying of otherwise protectible trade dress, resulting in substantial deception, unfair competition and consumer confusion.

INTEREST OF THE AMICUS CURIAE

INTA is a not-for-profit corporation of more than 2800 members having an interest in trademarks and trade dress. Its members include trademark and trade dress owners, advertising agencies, and law firms from the United States and

other countries, all interested in protecting the integrity of trademarks through a coherent and consistent legislative and judicial treatment of trademarks. At least two of the litigants, petitioner Conopco, Inc., and respondent May Department Stores Company, are members of INTA.[1]

INTA was founded in 1878 as The United States Trademark Association, with its first goal to encourage the enactment of federal trademark legislation. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with the first federal trademark law, the Lanham Act and amendments thereto, including the Trademark Law Revision Act of 1988. *See*, 134 Congressional Record S 16974 (daily ed. October 20, 1988) (statement of Sen. DeConcini).

Some of the world's foremost corporations are members of INTA. These members represent an important segment of the domestic and international business community. They and their counsel have substantial expertise in trademark law. INTA has participated as an *amicus curiae* in many trademark cases before this Court and in lower courts.

INTA takes no position as to whether or not respondent's trade dress in the instant case is likely to cause confusion, and thus infringes. This question of fact should be decided by the trier of the fact. INTA does take the position, however, that the Court's thoughtful analysis in *Two Pesos* compels the conclusion that trade dress is entitled to the same level of protection as trademarks.

INTA is concerned that the Federal Circuit has adopted a lesser standard of protection for trade dress by permitting a single factor—the presence of respondent's logo—to override any protectibility of trade dress. In a trademark case, that factor would be only one of the multiple factors to be considered

---

[1] Neither petitioner nor respondents, nor any representative of petitioner or respondents, has participated in the decision of INTA to seek leave to file this brief.

in determining the outcome. Such a lesser standard of protection is inconsistent with the Court's analysis in *Two Pesos*, and increases the public's exposure to likelihood of confusion, fraud and deception.

Accordingly, INTA urges the Court to grant the Petition for a Writ of Certiorari with respect to Questions 1 and 2. While these questions specifically refer to "store brand products," the issues they raise apply to trade dress generally.

SUMMARY OF ARGUMENT

By according trade dress a different, and lesser, level of protection than trademarks, the Federal Circuit ignored this Court's teaching that the same analysis applies to each.

Moreover, since the defendant in a trade dress case typically has used with its own trade dress a name or logo distinguishable from the plaintiff's name or logo, the rationale of the Federal Circuit decision could effectively destroy trade dress protection.

If trade dress is accorded a different and lesser standard of protection than trademarks, and protection is denied to trade dress merely because the imitator displays its own name or logo, the public will be deceived and defrauded.

ARGUMENT

A. The Decision of the Federal Circuit Ignores The Decision in *Two Pesos Inc.* v. *Taco Cabana Inc.*

In *Two Pesos*, the Court applied the same standard to a trade dress infringement case under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), as is applied to trademark infringement cases. Referring to the standard under the Act that inherently distinctive trademarks are to be protected without proof of secondary meaning, the Court stated:

> This is the rule generally applicable to trademark, and the protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition. *There is no persuasive reason to apply different analysis to the two.* 112 S.Ct. at 2760, 120 L.Ed.2d at 627 (emphasis added).

Thus, *Two Pesos* settled in the negative the question of whether it is necessary to prove secondary meaning for inherently distinctive trade dress since it is unnecessary to prove secondary meaning for inherently distinctive trademarks. And, as courts citing *Two Pesos* have recognized,[2] its teaching extends to trade dress protection generally.

In the instant case, the Federal Circuit did not even cite *Two Pesos*, let alone follow its rationale. Rather, the Federal Circuit provided a lesser standard of protection for trade dress cases: it held that the mere presence of respondent's logo on respondent's private label imitation of petitioner's trade dress

---

[2] See, *inter alia*, *Rubbermaid v. Contico Intern.*, 836 F.Supp. 1247, 1260 (W.D.Va. 1993) (citing *Two Pesos* for the general proposition that courts have accorded trade dress essentially the same protection as registered marks); *Allied Materials and Equipment v. Pappa Gepetto's Toys*, 28 USPQ2d 1862, 1864 (D.Kan. 1993) (citing *Two Pesos* for the general proposition that Section 43(a) of the Lanham Act prohibits use of false descriptions or representations in connection with the sale of goods and services); *Morton v. Rank America Inc.*, 812 F.Supp. 1062, 1065 (C.D.Cal. 1993) (citing *Two Pesos* for the proposition that a claim for trade dress infringement under the Lanham Act requires showing only that trade dress is (1) nonfunctional, (2) distinctive and (3) likely to cause confusion).

See also, Restatement (Third) of Unfair Competition § 16, pp. 156-57 and Comment (a) ("The scope of rights recognized in . . . [trade dress] is determined according to the general principles relating to infringement."); 1 J. Gilson, *Trademark Protection and Practice* § 7.02[7](g), p. 7-86 ("The likelihood of confusion factors which apply in trademark infringement cases also apply in Section 43(a) trade dress cases."); 1 J. McCarthy, *Trademarks and Unfair Competition* § 8.01[5], p. 8-11 (3d ed.) ("§ 43(a) has often been used as a vehicle by which to assert trade dress protection in the federal courts. In such § 43(a) cases, the traditional rules of trademark . . . law are applied.").

in and of itself rendered clearly erroneous the district court's finding of likelihood of confusion with the trade dress of petitioner's product.

It is well established in trademark cases that the putative infringer's use of its own name in conjunction with the allegedly infringing mark does not *per se* avoid likelihood of confusion. For example, in *Menendez* v. *Holt*, 128 U.S. 514, 521 (1888), the Court stated:

> [I]t is no answer to their action to say that there was no invasion of that right because the name of S.O. Ryder accompanied the brand upon the flour sold by appellants, instead of the name of Holt & Co. That is an aggravation, and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the true proprietor.

Indeed, in the Eighth Circuit case that the Federal Circuit purports to follow, *SquirtCo.* v. *Seven-Up Co.*, 628 F.2d 1086 (8th Cir. 1980), the court of appeals affirmed the district court's finding of likelihood of confusion, even though the defendant's well-known Seven-Up name prominently appeared on its product. 207 USPQ 12, 22 (E.D. Mo. 1979). The Eighth Circuit noted that the test for infringement "does not hinge on a single factor but requires consideration of numerous factors . . . ." 628 F.2d at 1091.

Here, the Federal Circuit held that the mere appearance of respondent's logo (without even respondent's name) required the conclusion that confusion was unlikely even though (1) petitioner's marks were "strong," (2) the trade dress was "extremely similar," (3) the products were "directly competitive" and (4) respondents acted with "deliberate intent to imitate and infringe."[3]

---

[3] The Federal Circuit said: "Even accepting these other findings as true, they are at best merely inferentially or presumptively relevant to the likelihood of confusion issue." The appearance of respondent's logo

Clearly, the Federal Circuit has applied to trade dress infringement cases a different, and lesser, standard of protection than that applied in trademark infringement cases. Since *Two Pesos* teaches that the standard must be the same, review by the Court is warranted.

B. Since the Typical Imitator in a Trade Dress Case Also Displays Its Own Name or Logo, the Federal Circuit's Decision Makes Trade Dress Protection Meaningless and Conflicts with Those of Other Circuits.

In almost every trade dress infringement case the imitator uses its own name or logo on the trade dress. For example, in *Two Pesos*, the plaintiff's Mexican restaurants prominently bore the name "Taco Cabana," while the infringing trade dress of the defendants' Mexican restaurant prominently included the clearly distinguishable name "Two Pesos." *See also*, *Paddington Corp. v. Attiki Importers & Distrib.*, 996 F.2d 577 (2d Cir. 1993), where the plaintiff's label bore the trademark NO 12 OUZO, while the defendant's infringing label displayed the noninfringing designation #1 OUZO); *Charles Jacquin Et Cie v. Destileria Serralles*, 921 F.2d 467 (3d Cir. 1990), where the plaintiff's bottle bore the trademark JACQUIN while the defendant's infringing bottle bore the trademark DON JUAN); *Nabisco Brands Inc. v. Conusa Corp.*, 14 USPQ2d 1324 (4th Cir. 1989), where the plaintiff's candy bore the mark LIFESAVER and the defendant's infringing candy bore the mark BARCA; *Badger Meter Inc. v. Grinnel Corp.*, 13 F.3d 1145 (7th Cir. 1994), where the trade dress of the defendant's HERSEY 430 SERIES II water meter was held to infringe the trade dress of the plaintiff's RECORDALL 25 water meter).[4]

---

on respondent's product was "[a] factor more probative of that issue . . . ." ___ F.3rd at ___, 32 USPQ2d at 1231-1232.

[4] In addition to these recent decisions from the regional circuits, there are a great number of similar district court decisions and earlier appellate decisions.

Thus, the Federal Circuit's interpretation of trade dress infringement law clearly is contrary to the law as stated in *Two Pesos*, and in conflict with the numerous cases in the regional courts of appeals in which trade dress infringements have been enjoined in spite of prominent display of the infringers' names.

Notwithstanding that the Federal Circuit purports to apply the law of the relevant regional circuits in trademark and trade dress infringement cases,[5] the impact of this inconsistency, and consequent uncertainty in the law, can be considerable. Because the Federal Circuit has exclusive jurisdiction over patent appeals, 28 U.S.C. § 1295, it hears all appeals in cases in which trade dress infringement claims are joined with patent claims. In addition, because of the Federal Circuit's relationship to the Trademark Trial and Appeal Board, 15 U.S.C. § 1071(a), the Federal Circuit may be perceived as having particular expertise in Lanham Act cases. If its decision in the instant case were followed by other courts, substantial damage would be done to the appropriate protectibility of trade dress.

C. In Substituting Its Own Factfinding for the Trial Court's Finding of Likelihood of Confusion, the Federal Circuit Contravened the Stated Intent of the Lanham Act to Protect Consumers From Deception.

In some cases the presence of the defendant's name or logo on putatively infringing trade dress will avoid likelihood of confusion; in other cases, it will not. Whether it does or does not is a question of fact, and can be answered only by the trier of the fact. Here, the Federal Circuit usurped the role of the

---

[5] While in the instant case the Federal Circuit purported to follow Eighth Circuit law, its decision fails to do so. For example, in the Eighth Circuit, "intent on the part of the alleged infringer to pass off its goods as the product of another raises an inference of likelihood of confusion" (*SquirtCo.*, 628 F.2d at 1091). In the instant case, however, the Federal Circuit gave no weight to the district court's finding that the defendants acted with "deliberate intent to imitate and infringe."

district court by holding, without any record support, that the mere presence of the respondent's logo negated the likelihood of confusion that the district court had found as a fact to exist.[6]

As Judge Mayer noted in dissent:

> I see no clear error in the [trial] court's finding that there is a likelihood of confusion . . . . This court's contrary conclusion on likelihood of confusion is reached by impermissibly reweighing the evidence that was before the trial court. This is not only beyond its competence but intrudes on the fact finding rules of the district court and encourages litigants to ignore the outcome of the trial and retry the case on appeal. Sometimes, like here, it works.

___ F.3d at ___, 32 USPQ2d at 1236.

The stated intent of the Lanham Act includes protection of consumers against being defrauded or deceived. 15 U.S.C. § 1127. If the Federal Circuit decision is permitted to stand, it will encourage the practice of greater fraud and deception

---

[6] The Federal Circuit also engaged in such impermissible fact finding in a previous trade dress case. In *L.A. Gear Inc.* v. *Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993), *cert. denied*, 114 S.Ct. 291, 126 L.Ed.2d 240 (1993), the district court had found that confusion was likely notwithstanding the prominent placement of the defendant's name on shoes whose trade dress was otherwise confusingly similar. The Federal Circuit reversed that finding by substituting its own unsupported view of the effect of such placement for that found below: "We agree with Appellants that purchasers of fashion athletic shoes are likely to be well aware of the sources of such shoes, when such sources are conspicuously marked by both copier and originator." 988 F.2d at 1134.

Dissenting in *L.A. Gear* (as he did on the same issue in the instant case), Judge Mayer specifically noted that the district court's findings were not clearly erroneous and that the majority had substituted its "hunch" for the district court's judgment. This is an impermissible intrusion on the fact finding role of the district court and a violation of the proper role of an appellate court." 988 F.2d at 1135.

in the form of more confusingly similar trade dress —albeit accompanied by the infringer's name or logo.

The Federal Circuit's impermissible fact finding extended even beyond the dispositive weight it gave to the presence of the respondent's logo. The district court had found the existence of actual confusion based on the testimony of a witness who purchased the respondent's product. She thought it to have originated with petitioner because she assumed that national brand manufacturers "secretly" market private brands.

The Federal Circuit rejected her testimony because it was based upon what the Federal Circuit considered to be an erroneous assumption. Not only did the Federal Circuit have no evidence in the record that her assumption was erroneous, but also it is well known that many national brand manufacturers have followed the practice of manufacturing private label versions of their products. For example, in *Fremont Co.* v. *ITT Continental Baking Co., Inc.*, 199 USPQ 415, 420 (S.D.N.Y. 1977), the court found:

> Furthermore, there is a practice in the food industry for manufacturers sometimes to manufacture and offer the same product for sale under a secondary brand name in packaging which is similar to the packaging used for the manufacturer's primary brand. *There is also a practice in the food industry on the part of some manufacturers to manufacture products for sale by another under a private label in packaging which is similar or substantially identical to the manufacturer's packaging for the same product.* Thus, the confusing similarity between plaintiffs' packages and defendant's packages may also be likely to confuse customers and potential customers into believing that plaintiffs' products are either a secondary brand or a private label manufactured by defendant. In either case, there is a likelihood of confusion as to source. (emphasis added)

Although the witness' testimony may not have been sufficient to support a finding of actual confusion for the purpose of entitling petitioner to monetary relief, it was relevant evidence on the issue of likelihood of confusion that the Federal Circuit should not have ignored.[7]

CONCLUSION

For the foregoing reasons, the Court should grant the Petition for a Writ of Certiorari.

Respectfully submitted,

ALBERT ROBIN*
MORTON DAVID GOLDBERG
BRUCE P. KELLER
Attorneys for International Trademark Association
1133 Avenue of the Americas
New York, New York 10036-6710
(212) 768-9887

**Counsel of Record*

[7] Under Eighth Circuit precedent, a trial court's determination on likelihood of confusion is a question of fact that may be reversed on appeal only if clearly erroneous. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (9th Cir. 1987), *cert. denied*, 488 U.S. 933 (1988).